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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,247	10/27/2003	Wayne Dawson	F-8015	5890
28107 7590 01/22/2009 JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168				
EXAMINER				
SKOWRONEK, KARL HEINZ R				
ART UNIT		PAPER NUMBER		
1631				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/695,247

Applicant(s)

DAWSON ET AL

Examiner

KARLHEINZ R. SKOWRONEK

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SD/CS)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Status

Claims 2-11 are pending.

Claims 1 and 12-13 are cancelled.

Claims 2-11 have been examined.

Claims 2-11 are rejected.

Response to Arguments

Regarding applicants summary of the status of the claims made in response dated 29 September 2008, it is unclear what applicant does not understand. Applicant states that the response of 29 September is responsive to the Office Action dated 27 June 2008. Applicant asserts the Office action summary recites claims 1-8, 11 and 13 are rejected. However, upon referring to the Office action issued on 27 June 2008, Office action summary states claims 2-11 are pending and that claims 2-11 are rejected. The body of the Office Action, under the heading of Claim Status also reiterates the status of the claims as recited on the Office action summary. Specifically, the Office Action recites "claims 2-11 are pending; claims 1 and 12-13 are cancelled; and claims 2-11 are being examined". Applicant is encouraged to verify that the response filed is to the correct Office Action. Claims 2-11 were rejected under 35 USC 101 in the Office Action dated 27 June 2008. Thus, the status of claims 9 and 10 is not unclear.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following rejection includes a new ground of rejection.

Claims 2-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 2-11 are directed to processes to predict the topology of the spatial arrangement of an amino acid sequence. The following analysis is taken from the guidance provided in the MPEP at 2104.IV, "Determine Whether the Claimed Invention Complies with 35 USC101". The claims are directed to processes. Here the claims are directed to the abstract idea of predicting spatial topology from predictions of free energy and other predicted thermodynamic potentials. The processes do not recite a physical transformation of matter from one state to another. Giving the claims the broadest reasonable interpretation, the claims read on mental steps. In *Comiskey* (*In re Comiskey*, 84 USPQ2d 1670) the court established that "the application of human intelligence to the solution of practical problems is not and of itself patentable" (at 1680). In *Comiskey*, the court stated explicitly "mental processes - or processes of human thinking - standing alone are not patentable even if they have a practical application" (at 1679). The court in *Comiskey* stated, "Following the lead of the Supreme Court, this court and our predecessor court have refused to find processes patentable when they merely claimed a mental process standing alone and untied to another category of statutory subject matter even when a practical application was claimed" (at 1680). The court's recent decision in *In re Bilski* confirmed, "a process is patent-eligible under 35 USC 101 if it is tied to a particular machine or apparatus or if it transforms a particular

article into a different state or thing" (*In re Bilski*, 88 USPQ at 1391, 2008). In the instant claims, the process is not tied to a class of statutory invention.

Claims 2-11 recite steps providing for receiving data as input and storing data as output. The inputs and outputs are insignificant extra-solution activity and do not represent a significant tie to another category of invention. The court in *Comiskey*, stated "the court rejected the notion that mere recitation of a practical application of an abstract idea makes it patentable, concluding that '[a] competent draftsman could attach some form of post-solution activity to almost any mathematical formula'" citing *Flook* (437 U.S. at 586, 590). The recent decision in *Bilski* confirmed the court's position regarding insignificant pre- or post-solution activity (i.e. insignificant extra-solution activity) as stated in *Comiskey* (see *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008) at p. 1396-1397). Applicant is encouraged to consider the recent BPAI informative decisions *Exparte Langemyr* (No. 2008-1495 (28 May 2008)) and *Exparte Biliski* (No. 2002-2257 (26 September 2006)) for further clarification of the above grounds of rejection.

The following is a reiteration from the previous Office Action.

Claims 2-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 2-11 are drawn to a process. A statutory process must include a step of a physical transformation, or produce a useful, concrete, and tangible result (*State Street Bank & Trust Co. v. Signature Financial Group Inc.* CAFC 47 USPQ2d 1596 (1998), *AT&T Corp. v. Excel Communications Inc.* (CAFC 50 USPQ2d 1447 (1999)). The instant claims do not result in a physical

transformation, thus the Examiner must determine if the instant claims include a useful, concrete, and tangible result.

As noted in *State Street Bank & Trust Co. v. Signature Financial Group Inc.* CAFC 47 USPQ2d 1596 (1998) below, the statutory category of the claimed subject matter is not relevant to a determination of whether the claimed subject matter produces a useful, concrete, and tangible result:

The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to – process, machine, manufacture, or composition of matter—but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other “conditions and requirements” of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. See *In re Warmerdam*, 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994). For purpose of our analysis, as noted above, claim 1 is directed to a machine programmed with the Hub and Spoke software and admittedly produces a “useful, concrete, and tangible result.” *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557. This renders it statutory subject matter, even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss.

In determining if the claimed subject matter produces a useful, concrete, and tangible result, the Examiner must determine each standard individually. For a claim to be “useful,” the claim must produce a result that is specific, and substantial. For a claim to be “concrete,” the process must have a result that is reproducible. For a claim to be “tangible,” the process must produce a real world result. Furthermore, the claim must be limited only to statutory embodiments.

Claims 2-11 do not require production of a tangible result in a form that is useful to the user of the process or apparatus. The claims are directed to a process to predict the topology of the arrangement of an amino acid sequence in which a calculation is performed to predict global folding kinetics and stored in a file or other form of digital memory. The output of the process as claimed results in an output that is not accessible to the practitioner of the process. The claim recites the output of information to a data file. The claims give no indication that the data file is in a form accessible to the

practitioner. In addition, the output does not appear the return the result of the method. The claim recites that "the information" is output. The term "the information" finds its antecedent basis in step b, in which information on secondary structure is prepared. Thus, the information that is output is not a cumulative result of the method, but rather is an intermediate result of the method. A tangible result requires that the claim must set forth a practical application to produce a real-world result. This rejection could be overcome by amendment of the claims to recite that a result of the process is outputted to a display, or to a user, or in a graphical format, or in a user readable format, or by including a result that is a physical transformation. The applicants are cautioned against introduction of new matter in an amendment.

Response to Arguments

Applicant's arguments filed 29 September 2008 have been fully considered but they are not persuasive. Applicant argues the storing steps as recited in the claims produce stored information that can be perceived graphically (p. 3, paragraph 2). The argument is not persuasive. The claims recite a step of "storing the information in a data file or in other form of digital memory". Giving the claims the broadest reasonable interpretation, the claims do not explicitly require the data file or digital memory to be physical. The specification is silent regarding the output of the method to any physical forms or forms that tangible to the practitioner of the process. Line 2-3 of page 9 of the specification recites the claim language of "storing the information in a data file or in other form of digital memory". Applicant argues that the claims recite a useful result and are thus statutory. The argument is not persuasive. One metric in evaluating if judicial

exception has a practical application is the determination of a result that is useful, concrete **and** tangible. The specification makes clear that topologies are useful in developing three dimensional protein models (specification, p. 1). Thus, the claimed method is useful. Given the same sequence data the claimed method would repeatedly produce the same result. That is the method is concrete or predictable. The claimed methods however do not produce a tangible result. Applicant argues that when functional material is embodied in computer readable material it is structurally and functionally integrated into the medium if the function of the functional material can be realized and that the figures in the specification demonstrate the function. This argument is not persuasive. Applicant appears to be misinterpreting MPEP 2106. In the instant case, "the information" is stored in digital memory. Information is data, data is not functional. For clarities sake, the first paragraph of MPEP 2106.01 is quoted below:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

The rejection is maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARLHEINZ R. SKOWRONEK whose telephone number is (571)272-9047. The examiner can normally be reached on 8:00am-5:00pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran can be reached on (571) 272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KARLHEINZ R SKOWRONEK/
Examiner, Art Unit 1631

22 January 2009